

REMARKS

Claims 1-6, 20-21 and 23-37 are pending. By this amendment, Applicant has amended claims 1, 23, 29 and 31 and cancelled claim 6. Applicant respectfully requests reconsideration of claims 1-5, 20-21 and 23-37 in view of the following remarks.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicants request that the Examiner carefully review any references discussed below to ensure that Applicants understanding and discussion of the references, if any, is consistent with the Examiner's understanding.

A. Claim Amendments

By this response, applicant has amended claims 1, 23 and 29 to further clarify the inventions recited therein. Applicant has amended claims 1, 23 and 29 to recite "wherein said first and base portions of said shoulder rest are part of a hollow body of said shoulder rest" which was recited in originally filed claim 6. As such, claim 6 has been cancelled. Furthermore, claims 1, 23 and 29 have been amended to recite "the first portion and the base portions being integrally formed to form said hollow body" which is clearly shown in Figure 1 of the originally filed specification. In addition, Applicant has amended claim 29 to recite "at least a portion of the base portions are configured to be selectively positioned closer together or farther away from each other", which limitation is present in existing claim 1. Claim 31 was amended to clarify the

claim consistent with the amendments to claim 29. As such, Applicant respectfully submits that no new matter has been introduced by the amendments and respectfully requests that the amendments to the claims be entered.

B. Reasserted Rejections Under 35 U.S.C. § 102 and 103

On Page 7, the Office Action stated that the Russo rejection by itself has been withdrawn. Applicant takes this to mean that the anticipation rejection based on Russo and the obviousness rejection based on Russo in view of Castle has been withdrawn. Applicant noted also that the anticipation/obviousness rejection based on Sutton '223 in view of Sutton '058 and the obviousness rejection based on Sutton '223 in view of Castle have not been reasserted. Thus, Applicant assumes the rejections applying Sutton have also been withdrawn. *However, if the Applicant is mistaken in any way, please advise as soon as possible so that the Applicant may have an opportunity to file a supplemental response.*

On pages 2-5 of the Office Action, claims 1-6, 21, 23, 25-33 and 35-36 are rejected under 35 U.S.C. §102(e) as anticipated by the Castle reference. By this amendment, claim 6 has been cancelled. As such, Applicant respectfully submits that the anticipation rejection with respect to claim 6 is rendered moot.

The Office Action asserted that with respect to independent claim 1, the Castle reference shows a shoulder rest comprising a first portion (400, 208, 204 in Fig. 13D) for abutting against a user's shoulder; base portions (196, 198; or 26, 28) extending from the first portion (400, 208, 204) to terminal ends, the terminal ends (29 on 28, a similar location for 26, 196, 198) of the base portions (196, 198; or 26, 28) configured for abutting against different longitudinal portions

of a back side of a handset (see Fig. 13D, 12, 12a, note 196, 198 wrapping/abutting around the back and ends of the handset); a cut out portion (between 196-198; between 26, 28) between the base portions; at least a portion of the base portions (196 or 198; 26, 28) are configured to be selectively positioned closer together or farther away from each other so that the shoulder rest can conform to differently shaped handsets (see Fig. 13D, 12, 12a).

Assuming *arguendo* that this characterization asserted by the Examiner is correct, the Castle reference does not teach "said first and base portions of said shoulder rest are part of a hollow body of said shoulder rest, the first portion and the base portions being integrally formed to form said hollow body" as recited in independent claim 1. Such a modification of Castle would destroy the intended function of the Castle reference which is to provide a distinct securement member 190 and a distinct decorative member 400. As such, Applicant respectfully requests that the anticipation rejection with respect to claim 1 based on the Castle reference be withdrawn.

Regarding claim 23, the Office Action asserted that Castle teaches a shoulder rest comprising a top portion (400, 208, 204 in Figure 13D) for abutting against a user's shoulder; a bottom portions (196, 198; or 26, 28) extending from the top portion (400, 208, 204), the bottom portion comprising first and second base portions (196, 198; or 26, 28) extending from the top portion, at least a portion of the base portions (196 or 198; 26, 28) are configured to be selectively positioned closer together or farther away from each other; a flexible strap (i.e., 22) extending between terminal ends (i.e., 29 on 28, and a similar location on 26) of the base portions (i.e., 26, 28).

However, assuming *arguendo* that this characterization asserted by the Examiner is correct, the Castle reference does not teach "said top portion and said bottom portion are part of a hollow body of said shoulder rest, said top portion and said bottom portion being integrally formed to form said hollow body" as recited in independent claim 23. Such a modification of Castle would destroy the intended function of the Castle reference which is to provide a distinct securement member 190 and a distinct decorative member 400. As such, Applicant respectfully requests that the anticipation rejection with respect to claim 23 based on the Castle reference be withdrawn.

Regarding claim 29, the Office Action asserted that Castle shows a shoulder rest comprising: a first portion comprising means (400, 208, 204 in Fig. 13D) for abutting against a user's shoulder; a second portion comprising a first base portion and a second base portions (196, 198; or 26, 28), and a space between 196, 198; or 26, 28), the second portion comprising means (196, 198; or 26, 28) for increasing or decreasing the size of the space so that the shoulder rest can conform to differently shaped handsets; means (loop formed by 196, 198; or 26, 28) for connecting the second portion to a handset so that the terminal ends (29 on 28, a similar location for 26) of the first and second base portions (196, 198; or 26, 28) are configured to abut against different longitudinal portion of a back side of a telephone handset (see Fig. 13D, 12, 12a).

However, assuming *arguendo* that this characterization asserted by the Examiner is correct, the Castle reference does not teach "said first and said second portion are part of a hollow body of said shoulder rest, said first portion and said second portion being integrally formed to form said hollow body" as recited in independent claim 29. Such a modification of

Castle would destroy the intended function of the Castle reference which is to provide a distinct securement member 190 and a distinct decorative member 400. As such, Applicant respectfully requests that the anticipation rejection with respect to claim 29 based on the Castle reference be withdrawn.

Claims 2-5, 21, 25-28, and 30-33, 35 and 36 depend from independent claims 1, 23 and/or 29 and thus incorporate the limitations thereof. As such, Applicant respectfully submits that claims 2-5, 21, 25-28, and 30-33, 35 and 36 are distinguishable over the cited references for at least the same reasons discussed above with respect to independent claims 1, 23 and/or 29. As such, Applicant respectfully requests that the anticipation rejection with respect to claims 2-5, 21, 25-28, and 30-33, 35 and 36 be withdrawn.

On page 5 of the Office Action, claims 20, 24, 34 and 37 are rejected under 35 U.S.C. §103(a) as being unpatentable over the Castle reference in view of the Russo reference. The Office Action asserted that the Castle reference shows the mounting of the shoulder rest onto the handset. However, the Castle reference does not teach an adhesive for such mounting. The Office Action further asserted that the Russo reference teaches providing an adhesive (i.e., reference numeral 28) for mounting the shoulder rest onto a handset. Applicant respectfully submits that even if the Russo reference teaches mounting a shoulder rest using an adhesive, that the combination of the Castle and Russo references do not teach or suggest "said first and base portions of said shoulder rest are part of a hollow body of said shoulder rest, the first portion and the base portions being integrally formed to form said hollow body" as recited in independent claim 1, "said top portion and said bottom portion are part of a hollow body of said shoulder rest,

said top portion and said bottom portion being integrally formed to form said hollow body" as recited in independent claim 23, or "said first and said second portion are part of a hollow body of said shoulder rest, said first portion and said second portion being integrally formed to form said hollow body" as recited in independent claim 29. Such a modification of Russo would destroy the intended function of the Russo reference which is to provide a distinct base and a distinct decorative figurine.

As such, Applicant respectfully submits that the combination of the Castle and Russo references does not teach or suggest the limitations of claims 1, 23 and/or 29. Because claims 20, 24, 34 and 37 depend from claims 1, 23 and/or 29, Applicant respectfully submits that claims 20, 24, 34 and 37 are distinguishable over the combination of the Castle and Russo references and thus requests that the obviousness rejection with respect to claims 20, 24, 34 and 37 be withdrawn.

D. New Rejection Under 35 U.S.C. § 102(b)

Page 5 and 6 of the Office Action rejected claims 29-34 under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 3,567,871 to Walter. The Walter reference teaches a telephone support device having a shoulder-engaging pocket 14 and a hand grip 16 on the top thereof. Also, the "[s]upport block 12 is formed with an inner, longitudinally concave surface 18 which is contoured to conform to the arcuate shape of shank portion 2 of handset 1. It will be seen that concave surface 18 extends lengthwise over arcuate back wall 20 of handset 1." '871 patent, col. 2, ll. 1-5 (emphasis added). Because the Walter reference teaches that the concave surface 18 of the support device 12 is configured to conform to the shape of the handset, it does not teach, "a

second portion comprising a first base portion and a second base portion having terminal ends and having a space formed therebetween . . . at least a portion of said first base portion and said second base portion are configured to be selectively positioned closer together or farther away from each other thus increasing or decreasing the size of the space so that the second portion can conform to differently shaped telephone handsets."

Nor would it be obvious in view of the Walter reference to make such modification. The Walter reference "has been particularly designed with a view towards providing a shoulder rest and support member for telephone handset of the type having a built-in dial wheel." '871 patent, col. 1, ll. 49-52 (emphasis added). Thus, the Walter reference clearly did not contemplate phones of various sizes, including cell phones. Hence, the degree of concavity of surface 18 of the support device 12 in the Walter reference is not sufficient to be able to maintain selective positioning to support different sized telephone handsets. As such, Applicant respectfully submits that the limitations of claim 29 are not anticipated or obvious in view of the Walter reference and respectfully requests that the anticipation rejection be withdrawn.

Claims 30-34 depend from independent claim 29 and thus incorporate the limitations thereof. As such, Applicant respectfully submits that claims 30-34 are distinguishable over the cited references for at least the same reasons discussed above with respect to independent claim 29. As such, Applicant respectfully requests that the anticipation rejection with respect to claims 30-34 be withdrawn.

No other rejections or objections were presented in the Office Action.

E. Conclusion

Amendment "D" and Response
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In view of the foregoing, Applicant believes that claims 1-5, 20-21 and 23-37 are allowable. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorney.

Dated this 26th day of July 2005.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Sara D. Jones", written in a cursive style.

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